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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,899	09/24/2003	Mitsuhiko Sato	CANO:087	2245

7590 09/14/2005

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EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT PAPER NUMBER

3651

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,899

Applicant(s)

SATO ET AL.

Examiner

Patrick H. Mackey

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed 8/1/2005 has been entered.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first sheet feed device that feeds each of the tab sheets of the predetermined tab sheet bundle to an image transfer position via a first conveying path with the tab sheet being inverted must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

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2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Regarding claims 1-10, the claims first recite “a predetermined tab sheet bundle”.

The claims go on to recite “a first sheet feed device that feeds each of the tab sheets of the predetermined tab sheet bundle” to an image transfer position via “a first conveying path with the tab sheet being inverted” and “a second sheet feed device that feeds each of the tab sheets of the predetermined tab sheet bundle” to the image transfer position via “a second conveying path without the tab sheet being inverted”. Finally, the claims recite a controller “to automatically select said first sheet feed device or said second sheet feed device. Thus, the claims recite one tab sheet bundle and the tab sheets are either fed to an image transfer position via a first feed device with a first conveying path that inverts the sheet or via a second feed device with a second conveying path that inverts the sheet. The specification, however, discloses a first tab sheet bundle with inverted tab sheets and a second tab sheet bundle without inverted tab sheets. There is no support in the specification for a conveying path that inverts sheets.

b. Regarding claims 9-12, the claims recite “a controller responsive to a tab sheet bundle being set in the normal order” or “a controller responsive to a tab sheet bundle being set in reverse order”. However, the specification does not disclose a controller that

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is responsive to the sheet bundle. Rather, the specification discloses a controller responsive to manual input regarding the sheet bundle.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nimura (JP 2000338729 A).

Response to Arguments

5. Applicant's arguments filed 8/1/2005 have been fully considered but they are not persuasive.

6. The applicant states that the drawings illustrate a first sheet feed device that feeds each of the tab sheets of the predetermined tab sheet bundle to an image transfer position via a first conveying path with the tab sheet being inverted because the drawings illustrate that that all sheets fed to a conveying path that inverts the sheets via the switching flapper and associated rollers described on page 31 of the specification. In response, the examiner notes that the conveying path that inverts the sheets is after the image transfer position. Therefore the path described on page 31 of the specification cannot be the claimed conveying path because it does not feed the sheets to an image transfer position. Rather, it feeds sheets from an image transfer position.

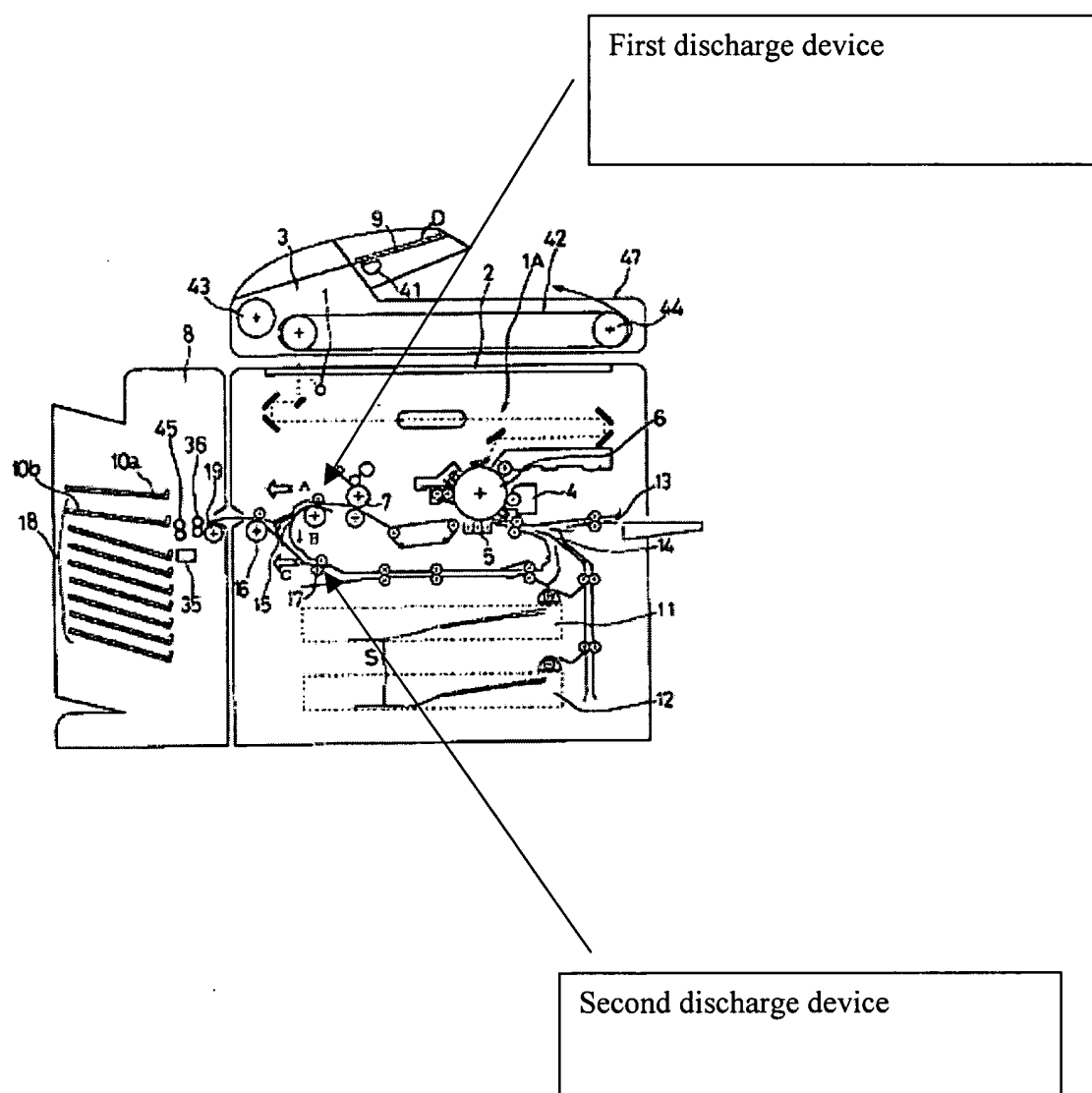
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7. In rebutting the rejection under 35 U.S.C. 112 1st paragraph, the applicant states that pages 28 and 31 demonstrate a conveying path that inverts sheets. The examiner agrees that pages 28 and 31 disclose a conveying path that inverts sheets. However, the conveying path that inverts the sheets is after the image transfer position. The claims recite that the conveying path that inverts the sheets is before the image transfer position.

8. The applicant states that Nimura does not disclose designating or selecting a bin onto which the tab sheets are discharged based on their orientation. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., designating or selecting a bin onto which the tab sheets are discharged based on their orientation) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. The applicant states that Nimura does not disclose or teach a sheet discharge device that discharges each tab sheet of the tab sheet bundle in a face- up state and another sheet discharge device that discharges each tab sheet of the tab sheet bundle in a face-down state, as set forth in claims 1-12. In response, the examiner has reproduced Fig. 1 which illustrates a first discharge device that discharges a tab sheet in a first orientation and a second discharge device that discharges the tab sheet in an inverted orientation.



Conclusion

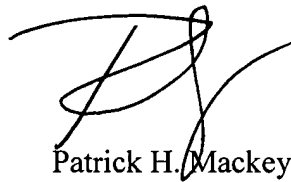
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick H. Mackey
Primary Examiner
Art Unit 3651

September 8, 2005